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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,835	08/30/2001	Vladimir Jovancevic	194-26872-US	3322

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,835

Applicant(s)

JOVANCICEVIC ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,10-13,16,17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,10-13,16,17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-3, 6-7, 10-13, 16-17 and 20 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 6, 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

3. Claims 1-3, 6-7, 10-13, 16-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Knox et al, 4,927,669. Knox et al (abstract; column 2, lines 30 et seq; examples and claims) discloses adding maleated fatty acids neutralized with

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imidazoline (amine) to a fluid in an amount (examples, Table I) of 750 and 6000 ppm of said fluid. The drag reducing function and an amount of the additive effective to reduce drag would have been inherent to the methods and compositions of Knox et al since the methods and compositions read on and are otherwise anticipate by the additive and addition thereof, i.e., method steps and concentrations read on their use as a corrosion inhibitor. The instant claims do and the instant disclosure does not preclude the inherent function of the instant claims from the ability to perform a corrosion inhibiting function as well as a drag reducing function.

The relationship of the drag reduction as a function of concentration would have been expected to have at least a minimum threshold to function, which would be above 100 ppm as the lower limit claimed. The relationship would be expected result in decreasing drag with increasing agent concentration to a maximum threshold. The claims merely require a reduction in drag and an effective amount to achieve said reduction. Since the reference adds the same agent at the upper end of applicants' concentration range, it is reasonable to conclude that said concentration is inherently an effective amount to reduce drag.

To the extent the 750 ppm does not include the amount of imidazoline base, a stoichiometric amount of imidazoline base (MW ~ 70) would result for a maleated fatty acid (MW ~ 400) in a concentration of less than 1000 ppm claimed (750 gm/kg / 400 gm/mol MW Acid x 470 gm/mol Acid + Base ~ 880 ppm).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 6-7, 10-13, 16-17 and 20 are directed to an invention not patentably distinct from claims 1-2, 4-5, 6, 8-10, 12-14, and 16 of currently commonly assigned to Baker Hughes Incorporated, Jovancicevic et al, US 6,774,094. Specifically, the claims are generic to the use of polycarboxylic acids (see column 2, lines 65 et seq) and salts thereof (see column 3, lines 21 et seq).

6. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned Jovancicevic et al, US 6,774,094¹, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can,

¹ Jovancicevic et al, US 6,774,094, contains related provisional application No. 60/286,228, which does not disclose or teach the same breadth with regard to the polycarboxylic acids as US 6,774,094. Specifically, column 2, lines 65 et seq; is not set forth as in US 6,774,094 but the dimer acids, trimer acids, and mixtures thereof. Jovancicevic et al, US 6,774,094, does not qualify as prior art under 35 USC 102(e).

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under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

7. Claims 1-3, 6-7, 10-13, 16-17 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 6, 8-10, 12-14, and 16 of U.S. Patent No. 6,774,094 in view of Knox et al, 4,927,669. US '094 discloses and claims methods and fluids for drag reduction. US '094 claims are generic to the use of polycarboxylic acids, which would include maleated fatty acids. US '094 (column 4, lines 21 et seq) discloses derivatives of the fatty acids, soaps of the fatty acids, and those used in corrosion inhibition as useful drag reducing agents.

To the extent the claims differ in the explicit disclosure of the use of the maleated fatty acid derivatives or the specific fatty acid derivatives claimed, Knox et al (column 4, examples, and Table I) discloses the use of maleinized² fatty acids, dimer/trimer fatty acids, and mixtures thereof with imidazoline for the advantage of corrosion inhibition. Corrosion inhibition is noted in the '094 and is clearly related art.

² The term "maleinized fatty acid" is deemed synonymous with "maleated fatty acid".

These references are combinable because they teach polycarboxylic acid derivatives as additives in oil/water systems. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the maleinized fatty acids with imidazoline for dimer/trimer fatty acids explicitly set forth in the US '094 reference as an obvious functional equivalent known in the oil/water system additive fields at the time of applicants' invention.

Attention is further directed to MPEP § 804: "The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970)."

Response to Arguments

8. Applicant's arguments with respect to claims 1-3, 6-7, 10-13, 16-17 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM